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PATENT APPLICATION

ATTORNEY DOCKET NO. 10002106-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Jerry B. Decime

Confirmation No.: 2157

Application No.: 09/746,365

Examiner: Lee, Philip

Filing Date: 12-21-00

Group Art Unit: 2152

Title: Method and System for Efficient Routing of Customer and Contact E-Mail Messages

Mail Stop Appeal Brief - Patents  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 7-25-06.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Jerry B. Decime

Serial No.: 09/746,365

Filed: December 21, 2000

Group Art Unit: 2152

Examiner: Lee, Philip

Docket No. 10002106-1

For: **Method and System for Efficient Routing of Customer and Contact E-Mail Messages**

**REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER**

Mail Stop: Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed July 25, 2006 has been carefully considered. In response thereto, please consider the following remarks.

**AUTHORIZATION TO DEBIT ACCOUNT**

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

## **REMARKS**

The Examiner has provided in the Examiner's Answer various responses to arguments contained in Applicant's Appeal Brief. Applicant addresses selected responses in the following.

### **1. Examiner Arguments as to Rejection under 35 U.S.C. § 112, Second Paragraph**

On pages 14 and 15 of the Examiner's Answer, the Examiner states:

It is unclear why the invention "determines the language in which the web-site is written" as claimed in claims 1-8, 10-14, 16-18 and 20-25 [i.e. does the invention infer the language of received email messages from the language in which the web-sites that received the email messages are written?]

*Examiner's Answer*, pages 14-15. From the above excerpt, it appears that the Examiner did not, until after the Appeal Brief was filed, understand Applicant's claimed invention. Perhaps that explains why the Examiner repeatedly rejected Applicant's claims in view of art that does not teach the various limitations of Applicant's claims. Regardless, the Examiner's question can generally be answered in the affirmative. Applicant's inventions infer what language an e-mail message is written in from the language of the web-site that was used to generate the e-mail message (e.g., an inquiry posted on the web-site). The concept is that it can be presumed that, for example, if the submitter of the e-mail message submitted the e-mail message while viewing a French-language web-site, the email message is likewise written in French. With such a mode of operation, the language recognition software taught by the prior art is unnecessary.

Irrespective of the Examiner's confusion, Applicant submits that Applicant's claims are clear and unambiguous, particularly when interpreted in light of the Applicant's specification.

Therefore, Applicant submits that the claims are not indefinite under 35 U.S.C. § 112, second paragraph.

The Examiner further argues that Applicant has submitted “evidence” that the claims fail to correspond to “that which applicant(s) regard as the invention.” Applicant replies by stating that the claims are what Applicant regards as the invention. Indeed, that is the purpose of the claims: to delineate the metes and bounds of what the applicant considers to be his invention. Applicant further asserts that Applicant did not present any “evidence” in the Response of May 23, 2005 that would indicate that the claims somehow do not correspond to the “invention.” The statement “applicant’s methods and apparatuses infer the language of received email messages from the language in which the web-sites that received the email messages are written” made in that Response is true and in agreement with the language of Applicant’s pending claims. Again, it appears that the Examiner is having difficulty in understanding Applicant’s invention.

Next, the Examiner states:

A web site usually is written with a specific language, and emails written from the web site are written using the same language. It is obvious that if a customer writes an email with a language different from the web-site language, it will be appended with a meta-tag that refer [sic] to the web-site language “a wrong one” [sic]

*Examiner’s Answer*, page 15.

Regarding the above statement, Applicant does not understand what the Examiner is trying to convey. It appears that the Examiner is making an argument as to an invention other than that being claimed by Applicant. Specifically, Applicant does not disclose or claim an invention that determines the language of an e-mail when that language is “different from the

web-site language.” Regardless, the issue of “obviousness” is only relevant to 35 U.S.C. § 103, not 35 U.S.C. § 112, second paragraph. As to 35 U.S.C. § 112, second paragraph, Applicant’s claims are clear and unambiguous and therefore are in compliance with 35 U.S.C. § 112, second paragraph.

## **2. Examiner Arguments as to Determining the Language of an E-mail Message**

On pages 15-16 of the Examiner’s Answer, the Examiner argues in regard to Applicant’s assertions regarding claim 1 that Applicant does not actually claim determining a language in which an e-mail message is written by determining the language of a web-site with which the e-mail message was generated. Applicant disagrees. Applicant’s claim 1 provides as follows:

1. An e-mail sorting and routing system, the system comprising:
  - a web server for providing a web-site at which clients generate e-mail messages to a host organization, *the web server being configured to determine the language in which the web-site is written and to append a meta-tag to each e-mail message that identifies that web-site language*; and
  - a response server configured to sort the e-mail messages by language through reference to the appended meta-tags.

As can be appreciated from above, Applicant claims a web server that is “configured to determine the language in which the web-site is written” and then “append a meta-tag to each email message” that was generated at the web-site that “identifies that web-site language”. Clearly, what Applicant is claiming is determining a language in which an e-mail message is written by determining the language in which the web-site at which the message was generated is written.

Although the language of claim 1 clearly pertains to determining a language in which an e-mail message is written, particularly in view of Applicant's specification which is to be consulted when interpreting the claims, it is true that claim 1 does not explicitly state "determining a language in which an e-mail message is written". Applicant notes, however, that claim 1 is still allowable over each of the applied references given that none of those references actually teach a web server "being configured to determine the language in which the web-site is written and to append a meta-tag to each e-mail message that identifies that web-site language". Therefore, even if the Examiner disagrees with Applicant's interpretation of claim 1 as determining a language in which an e-mail message is written, the fact remains that the references do not teach the limitations for which they were cited by the Examiner. Again, Applicant recites determining "the language in which the web-site is written", appending "a meta-tag to each e-mail message that identifies that web-site language", and sorting the e-mail messages by language "through reference to the appended meta-tags". The Newsbytes, WorldTrade, and Newswire articles relied upon by the Examiner, however, only teach using language recognition to recognize the language in which an e-mail message is written. Accordingly, the Examiner does not state a *prima facie* case of obviousness by failing to identify references that teach or suggest each claim limitation.

### **3. Examiner Arguments as to the Claimed "Web Server" and "Response Server"**

On page 16 of the Examiner's Answer, the Examiner, for the first time during prosecution of the instant application, addresses Applicant's explicit limitations regarding the claimed "web server" and "response server".

Although the Examiner makes various arguments as to the "inherency" of both a "web server" and a separate "response server" in the Newsbytes, WorldTrade, and Newswire articles,

Applicant notes that the fact is that none of the references teach a two server system as claimed by Applicant. The truth is that no one can determine from the articles whether a two server system is used in the systems described in the articles because precious little detail is provided as to the nature of those systems. The articles are mere reports of what the systems described in the articles do and no detail is provided as to the components of those systems. Although it is reasonable to assume that one web server is used in those systems, there is no basis to assume that those systems comprise a first server at which e-mail messages are generated and a second server that sorts those e-mail messages. For example, the e-mail messages in the systems of the articles could have been generated using an e-mail program such as Windows Outlook<sup>TM</sup>. Regardless, Applicant notes that the Examiner must establish the obviousness of Applicant's claims by identifying actual teachings or suggestions *from the prior art*. The Examiner clearly has not done so.

**4. Examiner's Arguments as to Determining the Language in which the Web-Site is Written, Appending a Meta-Tag to Each E-mail Message that Identifies that Web-Site Language, and Sorting the E-mail Messages by Language Through Reference to the Appended Meta-Tags**

Next, on page 16 of the Examiner's Answer, the Examiner, in essence, admits that the Newsbytes, WorldTrade, and Newswire articles do not actually teach determining "the language in which the web-site is written", appending "a meta-tag to each e-mail message that identifies that web-site language", and sorting the e-mail messages by language "through reference to the appended meta-tags". The Examiner, however, now states for the first time in prosecution of the instant application that those actions are obvious in view of the articles in view of Mowbray.

As an initial manner, Applicant objects to the fact that the Examiner raises the above argument for the first time in the Examiner's Answer. Applicant notes that the Mowbray reference has to this point only been cited to address the issue of sorting e-mail messages by topic. As provided in the final Office Action:

Newsbytes/ or WorldTrade/ or Newswire disclose sorting the e-mail messages on the basis of a language to be routed to appropriate agents for a fast processing, but do not sort the e-mail messages by topic. BusinessWire or Mowbray (abstract), on the other hand, sort e-mail messages by topic to be routed to appropriate agents for fast processing too.

*Final Office Action*, page 3. As can be appreciated from the above excerpt, not only did the Examiner not rely on the Mowbray reference as teaching or suggesting determining the language in which the web-site is written, appending a meta-tag to each e-mail message that identifies that web-site language, and sorting the e-mail messages by language through reference to the appended meta-tags, *the Examiner never even addressed those limitations of claim 1*. Instead, the Examiner vaguely referred to "sorting the e-mail message on the basis of a language." Therefore, the Examiner never "stated the combination of Newsbytes/ or WorldTrade/ or Newswire in view of Mowbray disclose the invention substantially as claimed" as alleged on page 17.

Irrespective of the Examiner's failure to address the limitations of Applicant's claims during prosecution, Applicant notes that, as described repeatedly throughout prosecution and appeal, none of the Newsbytes, WorldTrade, or Newswire articles teach or suggest determining "the language in which the web-site is written", appending "a meta-tag to each e-mail message that identifies that web-site language", and sorting the e-mail messages by language "through



reference to the appended meta-tags”. Again, those articles only teach using language recognition to analyze the language contained in an e-mail message.

Regarding the Mowbray reference, that Mowbray teaches appending a header of an e-mail message to identify a topic that the user explicitly specified does *not* render obvious (i) determining the language in which the web-site is written, (ii) appending a meta-tag to each e-mail message that identifies that web-site language, and (iii) sorting the e-mail messages by language through reference to the appended meta-tags. As a first matter, why would a person having ordinary skill in the art be motivated to modify the systems described in the Newsbytes, WorldTrade, or Newswire articles to append such a meta-tag to an e-mail message when the very purpose of those systems is to analyze the content of a received e-mail message? Clearly, a person having ordinary skill in the art would realize that such a modification would contravene the basic function of those systems’ existence and render them useless.

As a second matter, there is simply no reasonable way a person having ordinary skill in the art would arrive at Applicant’s invention in view of the various articles and the Mowbray reference. Again, the articles describe systems for analyzing messages to recognize the language in which they were written and Mowbray teaches appending an e-mail header with a topic that has been identified by the e-mail composer. Applicant asks how those disparate teachings would lead a person having ordinary skill in the art to (i) determining the language in which the web-site is written, (ii) appending a meta-tag to each e-mail message that identifies that web-site language, (iii) and sorting the e-mail messages by language through reference to the appended meta-tags. The Examiner provides no explanation on that point. Missing from the applied references is some teaching or suggestion to perform all of those specific actions. It appears clear that the only reference that provides the missing suggestions is Applicant’s own disclosure. As is well

established in the law, such hindsight to the Applicant's own disclosure is *per se* improper. See *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention).

Third, Applicant again asserts that none of the references teach "determining the language in which the web-site is written". The Examiner argues that the systems of the Newsbytes, WorldTrade, and Newswire articles teach that aspect of Applicant's claim 1. That is simply not true. Again, the systems of those articles determine the language of an e-mail message by analyzing the content of the e-mail message. At no time do those systems determine the language of a web-site that was used to generate the e-mail message. For one matter, the articles do not discuss how the e-mail messages are generated. Therefore, it is entirely possible that the e-mail messages are generated using an e-mail program entirely independent from a "web-site." In such a case, the language of a web-site clearly would not be determined by the prior art systems. As a second matter, even assuming that a web-site is used to generate the e-mail message, it is further possible that the e-mail message is written in different language than that of the e-mail message. For example, a Spanish speaking person in the U.S. may access Hewlett-Packard's English language web-site to submit a question written in Spanish in hopes that someone that speaks Spanish will be able to respond. In that case the language of a web-site again would not be determined. Applicant acknowledges that, in such a case, a false determination as to the language of an e-mail message could be made with Applicant's claimed invention. However, that fact pertains to the efficiency of Applicant's invention and not whether Applicant's invention is or is not patentable.

## **5. “New Grouping” of Rejections**

On page 18, the Examiner finally acknowledges the impropriety of the rejections as to claims 11, 12, 16, 17, 20, 21, 24, and 25. Although Applicant appreciates the Examiner’s admission as to that impropriety, Applicant respectfully submits that it comes too late. As identified in the Manual for Patent Examining Procedure (MPEP), the Examiner “should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.” *MPEP* § 706.07 (emphasis added). By ignoring Applicant’s identification of the impropriety of the rejections and presenting a proper rejection for the first time during appeal the Examiner has, in effect, denied Applicant an opportunity to respond to the allegations made Applicant’s claims and therefore has been denied a “full and fair hearing.”

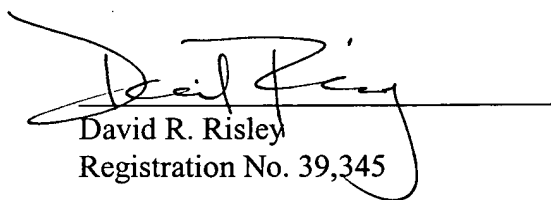
## **6. Examiner’s Arguments as to Sorting by Topic**

On page 19 of the Examiner’s Answer, the Examiner reiterates his arguments as to the obviousness of sorting e-mail messages by language and topic. In reply, Applicant again notes that none of the applied references teach or suggest “subsequently sorting” an e-mail message including “appending a meta-tag to each e-mail message that identifies the topic”, and “sorting the messages through reference to the topic meta-tags”. Although Ayyadurai generally teaches in column 4, lines 12-18 (cited by the Examiner) applying tags to e-mail messages containing “relative scores or rankings” for certain properties, Applicant notes that Ayyadurai fails to teach *sorting* e-mail messages using such tags.

### CONCLUSION

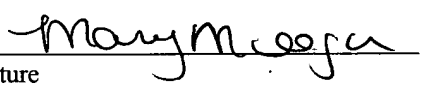
In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

  
David R. Risley  
Registration No. 39,345

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

8-28-06

  
Signature